

‘Outlook’’). Applicant respectfully traverses the rejection and requests reconsideration.

Response to New Arguments Raised by Examiner

The Examiner has argued as follows:

In response to applicant’s argument that the Outlook reference fails to qualify as prior art under 35 U.S.C. § 102(b) the Examiner respectfully disagrees. The publishing date of MICROSOFT OUTLOOK 2000, as demonstrated by the newly cited copyright registration record, is 10 June 1999. Therefore, any demonstrated usage of Outlook may rely upon the given publishing date. Thus, the Examiner contends that the cited Outlook reference is valid prior art under 35 U.S.C. § 102(b).

It appears from the above statement that the Examiner has missed the point of Applicant’s argument.

Applicant recognizes that a publishing date of June 10, 1999 is more than one year prior to the filing date (July 26, 2001) of the present application. Therefore, any material that is included within such a publication qualifies as prior art under 35 U.S.C. § 102 (b).

However, Applicant notes that what Examiner has called “Outlook”, was not included within the copyrighted material published on June 10, 1999.

Specifically, Figure 2 and Figure 3 of what Examiner has called “Outlook” are apparently screen shots Examiner has created with the use of the product MICROSOFT OUTLOOK 2000, available from Microsoft Corporation. Applicant does not believe that Figure 2 and Figure 3 of what Examiner has called

“Outlook” actually appeared in any publication that was available to the public prior to July 26, 2000 (one year prior to the filing date of the present application).

Examiner has failed to recognize that there is a difference between a computer program, and works created with the aid of a computer program. Specifically, Examiner has asserted the following: “... any demonstrated usage of Outlook may rely upon the given publishing date.” This is clearly a wrong standard for evaluating claims in a patent application.

For example, an examiner examining a patent application should be able, after reading a claim in a patent application, to use the drawing feature within Microsoft Office (provided the examiner is proficient with this program) to create a drawing that corresponds to the subject matter set out in the claim.

The examiner, however, cannot assert that the drawing that the examiner himself created is prior art, and that the drawing is according a publication date based on the publication of the computer program (Microsoft Office) used to create the drawing.

If this were the criteria by which claims were evaluated, it is difficult to see how any claim could survive scrutiny. It is always possible to use a computer program to generate information that discloses the claimed subject matter of an invention. The vast majority of patent applications are written using computer programs. Thus, an examiner should always be able to reproduce the subject matter set out in any claim using a computer program.

However, such a reproduction by the examiner should not be regarded as having the same publication date as the publication date of the computer program the examiner uses to create the reproduction.

In effect, this is what Examiner has done in this case. Examiner has used the program MICROSOFT OUTLOOK 2000, available from Microsoft Corporation to produce Figures 2 and 3 of the reference that Examiner has called "Outlook". Examiner has argued that Figures 2 and 3, which Examiner has himself created, should be regarded as having the same publication date as the computer program MICROSOFT OUTLOOK 2000, available from Microsoft Corporation. This is a fallacious argument.

Reiteration of Reasons for Traversal

Applicant herebelow reiterates the reasons for traversal of the rejection of claims 1 through 14 under 35 U.S.C. § 102(b).

Criteria for a Rejection under 35 U.S.C. § 102(b)

35 U.S.C. § 102 (b) states that a person shall be entitled to a patent unless "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

Examiner has failed to cite art that qualifies as prior art under 35 U.S.C. § 102 (b).

Discussion of art cited by Examiner

Examiner has rejected claims 1 through 14 under 35 U.S.C. § 102 (b) as being anticipated by what Examiner has called "Outlook".

Applicant's copy of what Examiner has called "Outlook" is poor, with much of the dark sections being completely blacked out. However, enough of what Examiner has called "Outlook" is decipherable to make clear that what Examiner has called "Outlook" does not qualify as prior art under 35 U.S.C. § 102 (b).

What Examiner has called "Outlook" includes three Figures. According to Examiner, Figure 1 includes copyright and publication dates for Microsoft Corporation's software program MICROSOFT OUTLOOK 2000. Applicant is relying on Examiner's description of this Figure as the print on Figure 1 is unreadable in the copy received by Applicant.

From the readable parts of Figure 2, it looks like Examiner has printed a screen shot of an untitled e-mail message that Examiner has prepared. It looks like the e-mail message is variously addressed to Roswell, Michael; 2173 Examiners; Detwiler, Brian; 2174 Examiners; Bonshock, Dennis; 2179 Examiners and Cabeca, John. In the part of the e-mail message where the message text normally is placed, Examiner has apparently typed the phrase: "Do not send to: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler".

From the readable parts of Figure 3, it looks like Examiner has printed a screen shot of the same untitled e-mail message shown in Figure 2, with some minor modifications. Specifically, it looks like Examiner has removed some of addresses from the untitled e-mail message shown in Figure 2. Specifically, Examiner has removed the names: Michael Roswell; 2174 Examiners; John Cabeca; Brian Detwiler.

In order for Figures 2 and 3 of what Examiner has called "Outlook" to qualify as prior art under 35 U.S.C. § 102 (b), it would be necessary for Examiner to show that Figures 2 and 3 of what Examiner has called "Outlook" were in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in the United States. However, it is clear that Figures 2 and 3 are very recent creations by Examiner and were not published before July 26, 2000 (one year prior to the filing date of the present application). Therefore, Figures 2 and 3 of what Examiner has called "Outlook" are not available as prior art for purposes of evaluating the claims of the present case under 35 U.S.C. § 102(b).

Applicant notes that it should be possible in light of the teaching in Applicant's Specification, to modify Microsoft Corporation's software program MICROSOFT OUTLOOK 2000 in a way to fall within the subject matter set out in the claims of the present case. However, such a modification or use of Microsoft Corporation's software program MICROSOFT OUTLOOK 2000 to, in hindsight from Applicant's Specification, recreate the subject matter set out in the claims of

the present case only serves to show that Applicant has satisfied the requirement of first paragraph of 35 U.S.C. § 112 that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

Examiner's ability to modify or use Microsoft Corporation's software program MICROSOFT OUTLOOK 2000, in hindsight from Applicant's teaching, to reproduce the subject of the claims of the present case does not demonstrate that the subject matter of the claims is anticipated. For anticipation under 35 U.S.C. § 102 (b), Examiner must show that such a modification or use occurred before July 26, 2000 (one year prior to the filing date of the present Application).

Conclusion

Applicant believes the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
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